



Attorney Docket No. Q58939
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Kenichi NAKAMA, et al.

Appln. No.: 09/529,990

Confirmation No.: 7259

Group Art Unit: 1762

Filed: April 24, 2000

Examiner: Alicia Ann Chevalier

For: MULTILAYER-COATED SUBSTRATE AND PROCESS FOR PRODUCING THE
SAME

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated February 7, 2002 in which the Examiner has required restriction, Applicants respond by electing Group I, claims 1-12, drawn to a multi-layer coated substrate. The election is with traverse.

Applicants submit that the requirement for restriction is improper and should be withdrawn.

In PCT applications such as the present application, restriction is proper only in the absence of "unity of invention." See 37 C.F.R. § 1.475. Rule 1.475(b)(1) expressly provides that a PCT application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to "A product and a process specially adapted for the manufacture of said product."

MPEP §1893.03(d) on unity of invention explains that:

...A process is “specially adapted” for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression “specially adapted” does not imply that the product could not also be manufactured by a different process.

Here, claims 1-12 (Group I) are drawn to a product (a multi-layer coated substrate) and claims 13-16 (Group II) are drawn to a process specially adapted for the manufacture of the product (i.e., they are drawn to a process for producing the multi-layer coated substrate). The process of the Group II claims inherently produces the claimed multi-layer coated substrate of the Group I claims. As seen in the MPEP quoted above, in PCT applications it is irrelevant whether the product can also be manufactured by a different process, which has not been shown in any event.

Further, Applicants disagree with the Examiner’s assertion that evidence of lack of unity between the two groups is found in Andras ‘596. Here, the two groups of claims are drawn to a product and a process specially adapted for the manufacture of that product; thus, the two groups satisfy the “unity of invention” requirement. Whether the “features” of an individual claim are found in the prior art is irrelevant to the issue of unity of invention and the propriety of the restriction requirement. Further, Applicants do not agree that Andras ‘596 discloses the features of instant claim 1, although it is not believed necessary to address the issue of patentability on the merits in the present response.

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For the above reasons, Applicants respectfully submit that the requirement for restriction should be reconsidered and withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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